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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,335	08/01/2003	Johnathan P. Tann	13552.4003	3599
34313	7590	11/08/2005	EXAMINER	
ORRICK, HERRINGTON & SUTCLIFFE, LLP			QUELER, ADAM M	
IP PROSECUTION DEPARTMENT			ART UNIT	PAPER NUMBER
4 PARK PLAZA				2178
SUITE 1600				
IRVINE, CA 92614-2558			DATE MAILED: 11/08/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/632,335	TANN ET AL.	
	Examiner	Art Unit	
	Adam M. Queler	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 August 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/05 10/03/03</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed 08/01/2003, and Information Disclosure Statements (IDS) filed 03/25/2005 and 10/03/2003.
2. Claims 1-20 are pending in the case. Claims 1 and 11 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 9-10 and 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant only describes removal at zero, not a maximum value.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 9-10 and 19-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims do not make logical sense, as the independent claims recite decrementing a counter, and the dependent claims recite removal at a maximum value. For examining purposes

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only, the claims will be understood to be removing the content at zero, as is recited in the specification.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-8, and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl et al. (US 20020091930A1), and further in view of Applicant's Admitted Prior Art.**

Regarding independent claim(s) 1 and 11, Kohl teaches installing a counter on to the device (para. 36). Kohl teaches that the content has been played, or presented (para. 37). Inherently, there must have been a player. Kohl teaches setting the counter to a specific value, 5, (para. 37), and using it to keep track of the allowable amount of plays (para. 37), though does not explicitly state that it is decrementing the counter. However, since the counter starts at the maximum allowed value, and is a counter recording the number of allowable plays, inherently, the counter must be decremented.

Kohl does not explicitly disclose the counter and content are on removable media. However, Applicant admits that removable media was a popular way get content on devices (p. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use removable media as it was popular to use at the time of the invention and would

have increased user acceptance. Inherently, then the counter must have been searched for and installed.

Kohl does not explicitly teach a handheld device, but rather or more general computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to carry out the steps in the order claimed as it has been held the making a device portable is *prima facie* obvious in the absence of new or unexpected results, *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952).

Regarding dependent claim(s) 2 and 12, Kohl teaches multimedia (para. 25)

Regarding dependent claim(s) 3 and 13, Kohl teaches audio files (para. 25).

Regarding dependent claim(s) 4 and 14, Kohl teaches videos, which comprise at least one graphical image (para. 25).

Regarding dependent claim(s) 5–8 and 15–18, as the intended use in different media would not result in a manipulative difference the prior art and the claimed invention(s); the claims are similarly rejected as claims 8 and 13 above. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) and *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962).

9. Claims 9, 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl and Applicant's Admitted Prior Art as applied to claims 1 and 11 above, and further in view of Headings et al. (US 20020144283A1).

Regarding dependent claim(s) 9, 10, 19 and 20, Kohl teaches that when counter expires, the license expires. Kohl does not explicitly disclose deleting the data when the license expires. Headings teaches deleting content when the license expires (para. 28). It would have been obvious to one of ordinary skill in the art at the time of the invention to delete the content in

order to comply with various copyrights and distribution rules (Headings, para. 3). Additional motivation is found in the nature of the problem to be solved, which is protecting copyrighted content. Protection of content cannot be any more effective than permanently removing a would-be infringer's possession of the content.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

11/4/2005